

ATTACHMENT A

Remarks

The interview held with the Examiner on February 12, 2004, is gratefully acknowledged. The interview centered around the "new matter" objection and related issues discussed below. Tentative agreement was reached. The substance of the discussion at the interview is incorporated in the remarks which follow.

Considering the matters raised in the Office Action in the same order as raised, the Examiner contends that the "record shows that some embodiments have been added into some claims" and has objected to the previous amendment "under 35 U.S.C. 132 because it introduces new matter into the disclosure." In particular, the Examiner contends that claim 1 includes the "new added embodiments:

- (1) 'to a controlled level,'
- (2) 'the outer container having...in the hydraulic cylinder'."

Applicant has been "required to cancel the new matter in the reply to this Office Action."

Further, claim 1 and the dependent claims have been rejected under 35 USC 112, first paragraph, as "failing to comply with the written description requirement." This involves the same issues and the same allegedly "new added embodiments."

As discussed during the interview, the first so-called "embodiment," i.e., the claim language "to a controlled level" is fully supported by lines 20-22 of page 11 of the specification and, in this regard, the precise language "to a controlled level" is used in the passage in question. The Examiner agreed during the interview that this language is supported by the specification and does not constitute "new matter."

With respect to the second "embodiment" or phrase, it is respectfully submitted that this phrase is supported by the specification at lines 22 to 25 of the same page (page 11). The passage at these lines provides that "pressurization was accomplished using a small hydraulic cylinder 37 (see Figure 3) connected to the chamber and which is loaded by a manually adjusted screw 38." Thus, the pressurization provided by the hydraulic cylinder is the pressurization of the transmission fluid to a controlled level so that the pressure applied is necessarily a predetermined pressure in order to provide pressurization of the transmission fluid to a controlled level.

Based on the discussions at the interview, the Examiner takes a different position and still objects to the word “predetermined” in the second phrase. On the other hand, the Examiner has agreed that this phrase is otherwise supported by the above-mentioned lines of the specification. Thus, the only issue remaining is whether the word “predetermined” is supported by the specification and, in order to expedite the prosecution, applicant has simply canceled this word, even though it is the position of the applicant that use of this word is justified and supported by the specification for the reasons discussed above.

Finally, the Examiner has taken the position that an additional search will be required because of the deletion of the word “predetermined.” In the Office Action, the Examiner has stated that the newly amended claims “have been considered and searched but Bolleman et al (5,395,592) is insufficient to disclose and teach the newly added embodiments.” The “embodiment” in question here, i.e., the recitation that the pressurization means comprises a hydraulic cylinder connected to the interior of the outer container and that the hydraulic cylinder includes a piston therein and means for applying a predetermined pressure to the piston in the hydraulic cylinder, clearly defines over the Bolleman et al reference whether the applied pressure is stated to be “a pressure “ or “a predetermined pressure” and there is certainly no reason to conduct an additional search because of the omission of the word “predetermined” made to satisfy the objection raised by the Examiner. Thus, with all due respect to the Examiner, given this background, a new search will simply not be required here.

Turning now to the formal matter raised in paragraph IV, the amendment in question concerns the claims or, more accurately, the introduction to the claims on the same page as claim 1, as indicated in the Amendment. Thus, it is believed that the location of the change is properly identified.

Allowance of the application in its present form is respectfully solicited.